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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/805,196	03/14/2001	Christopher Paul Kenneth Smithies	111828.120US1	1727

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WILMER CUTLER PICKERING HALE AND DORR LLP
399 PARK AVENUE
NEW YORK, NY 10022

EXAMINER

VIG, NARESH

ART UNIT

PAPER NUMBER

3629

DATE MAILED: 10/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/805,196	SMITHIES ET AL.	
	Examiner	Art Unit	
	Naresh Vig	3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 August 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11,13,14,16,22,23,28 and 29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 11,13,14,16,22,23,28 and 29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>20010823; 20010621; 20050831</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Applicant's election with traverse of claims 11, 13, 14, 16, 22, 23, 28 and 29 in the reply filed on 03 August 2006 is acknowledged. The traversal is on the ground(s) that the claims are related. This is not found persuasive because for example, Group I requires the relying party which has received a transaction identifier, transmit the received transaction identifier to affirming party which is used by the affirming party to assent to the transaction, establishing of electronic communication between relying party and affirming party which would require a different search that the search required for elected invention because elected invention establishes communication between affirming party and the recording system.

Since both non-elected claim 12 and elected claim 13 claim dependency of the independent claim 11, when written as an independent claim respectively, they would require different search.

Since both non-elected claim 15 and elected claim 14 claim dependency of the independent claim 11, when written as an independent claim respectively, they would require different search.

The requirement is still deemed proper and is therefore made FINAL.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 11, 13, 14, 16, 22, 23, 28 and 29 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

Additionally, for a claimed invention to be statutory, the claimed invention must produce a useful, concrete, and tangible result. In the present case, the claimed invention merely receives a transaction identifier from a user, but, this identifier is a user defined identifier with no assurance that the received identifier is not a duplicate identifier otherwise the claimed invention will not be able to identify which transaction does the assent be associated with. In addition, there is no provision in the claimed invention as to who provided the transaction identifier to the user(s) to produce tangible results. Since the claimed invention, as a whole, does not produce tangible results, claims 11, 13, 14, 16, 22, 23, 28 and 29 are deemed to be directed to non-statutory subject matter.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 11, 13, 14, 16, 22, 23, 28 and 29 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted steps are for example:

Receiving of a transaction identifier be a user to produce tangible results

Ensuring all the parties involved in a transaction use the same transaction identifier.

Claims 11, 13, 14, 16, 28 and 29 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention because these claims recite a limitation of method step of receiving a transaction identifier at the voice recording system but applicant has not positively claimed how the received transaction identifier is used in the claimed invention.

Claims 22 and 23 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention because these claims recite a limitation of method step of receiving a declaration identifier from an affirming party, but applicant has not

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positively claimed how the received declaration identifier is used in the claimed invention.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 11, 13, 14, 16, 22, 23, 28 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Matthew et al. US Patent 4,580,012.

Regarding claims 11 and 28, Matthews teaches recording audio messages using a voice recording system. Matthews does not explicitly teaches audio message is consent to a transaction. However, applicant is claiming content of an audio message as their invention.

Matthew teaches recording audio messages on a voice recording system, therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made that Matthew can be used for recording audio messages which contain message fro consent to a transaction.

Matthew teaches capability for being used between plurality of parties for storing and delivering audio messages. Matthew teaches capability for:

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receiving a transaction identifier at the voice recording system (identification of the recipient of the audio recording) [Fig. 13 and disclosure associated with Fig. 13].

recording a voice message received from the affirming party. Matthew does not explicitly teach the voice message indicating that the affirming party assents to the transaction (applicant is claiming content of the audio recording as their claimed invention). Matthew teaches capability for user to record audio messages [Fig. 14 and disclosure associated with Fig. 14].

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made that is capable for recording audio messages with the content indicating that the affirming party assents to the transaction.

storing the voice message in the voice recording system (inherent, Matthew teaches recipient can play the audio message at a later time)

associating a recording identifier with the recorded voice message (Matthew teaches retrieving plurality of messages for the recipient) [Fig. 21 and disclosure associated with Fig. 21].

Regarding claim 13, Matthew teaches transaction identifier after establishment of communications between the affirming party and the recording system [Fig. 13 and disclosure associated with Fig. 13].

Regarding claim 14 and 29, Matthew does not explicitly teach providing the recording identifier to the relying party. However, Matthew teaches capability for notifying user [Fig. 15 and disclosure associated with Fig. 15].

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made that Matthew is capable of providing recording identifier as a notification to the recipient.

Regarding claim 16, as responded to earlier in response to claim 11, Matthew teaches notifying the relying party that the voice message has been stored.

Regarding claim 22, as responded to earlier in response to claim 11, Matthew teaches capability of recording a solemn declaration (applicant is claiming content of audio message as their invention). Matthew teaches capability for:

receiving a declaration identifier from an affirming party, the declaration identifier corresponding to the declaration (identification of the recipient of the audio recording) [Fig. 13 and disclosure associated with Fig. 13]

receiving a voice message from the affirming party. Matthew does not explicitly teach the voice message indicating that the voice message includes a statement of the solemn declaration (applicant is claiming content of the audio recording as their claimed invention). Matthew teaches capability for user to record audio messages [Fig.14 and disclosure associated with Fig. 14].

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Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made that is capable for recording audio messages with the content indicating that the voice message includes a statement of the solemn declaration.

recording and storing the voice message (inherent, Matthew teaches recipient can play the audio message at a later time)

associating a recording identifier with the recorded voice message (Matthew teaches retrieving plurality of messages for the recipient) [Fig. 21 and disclosure associated with Fig. 21].

Regarding claim 23, Matthews does not explicitly teach communicating the declaration identifier from a recording system to a relying party, prior to the step of receiving a declaration identifier. However, Matthew teaches transmitting identifier to recipient [claim 1, 25].

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made that Matthew is capable of communicating identifier to recipient as desired by the business to meet their business objectives.

Conclusion

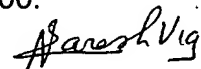
The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Applicant is required under 37 CFR '1.111 (c) to consider the references fully when responding to this office action.

1. Feller US Patent 5,159,180

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Naresh Vig whose telephone number is (571) 272-6810. The examiner can normally be reached on M-F 7:30 - 6:00 (Wednesday off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Naresh Vig
Examiner
Art Unit 3629

September 25, 2006